

REMARKS

Applicant thanks the Examiner for acknowledging the claim for foreign priority and the receipt of the priority documents in support thereof. On the Office Action Summary Form, Box 13(a) was checked, indicating that the Examiner received all of the priority documents. However, box 13, was not checked. Applicant requests that the Examiner acknowledge explicitly the claim for foreign priority.

Applicant thanks the Examiner for reviewing and considering the references cited in the Information Disclosure Statement filed November 28, 1998.

Applicant thanks the draftsperson for approving the Drawings. We note that in the Office Action, page 2, the Examiner stated that a drawing correction is required. However, the Examiner did not point out any problems with the drawings. On June 24, 2002, the Examiner stated in response to a telephone enquiry that the statement in the Office Action requiring drawing correction was a mistake, and that no correction to the drawings is required. The Examiner further stated that he will clarify in writing that no objection to the drawings has been made.

New claim 11 has been added. Therefore, claims 1-11 are the claims now pending in the application.

Rejection of Claims 1 and 2 under 35 U.S.C. § 103

The Examiner rejected claims 1-2 under 35 U.S.C. § 103, as obvious over Sussman, U.S. Patent No. 5,483,586 and in view of Peterson, U.S. Patent No. 5,509,049. Applicant assumes

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that the Examiner intended to reject claims 3-4 and 6-10 on this basis as well, since the Office Action includes purported grounds for rejection for these claims as well. These rejection are traversed.

Applicant's claimed invention is directed to unique and nonobvious systems and methods for transmitting a telephone number of a desired subscriber. In pertinent part, claim 1 requires, *inter alia*, transmitting a telephone number from the directory enquiry facility to the terminal on a second channel.

Sussman discloses an on-line telephone number directory that periodically downloads telephone numbers from an on-line directory to update a user's database. The Examiner acknowledges that Sussman does not disclose a telephone network with a first channel for voice transmission and a second channel for data transmission. (Office Action, Page 4) The Examiner points to Peterson col. 7, lines 26-49 and alleges that this passage discloses this limitation.

Peterson discloses a method and apparatus for automatic dialing of a number received from directory assistance from within a cellular system. Peterson, at col. 7, lines 26-49 discloses an embodiment, in which a central office, Mobile Telephone Switching Office (MTSO), is connected to one or more base transceiver stations (BTSS) via by for example an ISDN using a Basis Rate Interface, BRI. The Examiner cites this passage and argues that (1) a second D-channel is inherent in an ISDN system and (2) the D-channel in an ISDN can carry data in addition to control and signaling information.

However, first, merely because a D-channel in an ISDN system can carry data does not mean that it is inherent that the D-channel be used to transmit a telephone number, as *inter alia*,

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required by claim 1. Inherency requires that a person of ordinary skill in the art would recognize that the function is necessarily present in the disclosed method, not merely that the method be capable of carrying out the function.

Further, Peterson discloses that the ISDN line connects the Mobile Telephone Switching Office (MTSO) to the Base Transceiver Station (BTS), and not a directory enquiry facility to a terminal, as *inter alia* required by claim 1. (Col. 7, lines 32-37) Peterson discloses a cellular telephone system, and therefore it is not the case that the MTSO is connected to the user terminal via an ISDN line.

Therefore, the combination of Sussman and Peterson does not disclose Applicant's invention as claimed by claim 1.

Claims 2-4, 6-7, and 9 depend from independent claim 1, and therefore incorporate all of the limitations thereof. Accordingly, claims 2-4, 6-7, and 9 are patentably distinguishable over the prior art for at least the reason that independent claim 1 is patentably distinguishable.

Independent claim 8 requires, *inter alia*, a transmitter that transmits a numeric string on the second channel. Independent claim 10 requires, *inter alia*, a terminal capable of receiving on a second channel a telephone number. Accordingly, claims 8 and 10 are patentably distinguishable over the prior art for reasons analogous for purposes of the present discussion to the reasons why claim 1 is patentably distinguishable over the prior art.

Rejection of Claim 5 under 35 U.S.C. §103

The Examiner rejected claim 5 under 35 U.S.C. §103, as obvious over Sussman and Peterson and further in view of Rondeau, U.S. Patent No. 5,850,433. This rejection is traversed.

Claim 5 depends from independent claim 1 and therefore incorporates all of the limitations thereof. Rondeau discloses a system and method for providing an on-line directory service. Rondeau does not cure the deficiencies of Sussman and Peterson as they relate to Applicant's claimed invention. Therefore the combination of Sussman, Peterson and Rondeau does not disclose Applicant's invention as claimed by claim 5.

In addition, the Examiner states that Rondeau discloses a global system for mobile telecommunications (GSM) system and argues that (1) a second channel, such an organizational channel is inherent to a GSM, and (2) an organization channel may be used as a second channel that transmits a telephone number. However, merely because a GSM organization channel may be used to transmit a telephone number, it does not follow that it is inherent that the GSM system of Rondeau discloses a second channel that transmits a telephone number, as *inter alia*, required by claim 5. Inherency requires that a person of ordinary skill in the art would recognize that the function is necessarily present in the disclosed method, not merely that the method be capable of carrying out the function.

New claim 11 has been added. Claim 11 patentably distinguishes over the prior art for reasons analogous for purposes of the present discussion to those presented above for claims 1-10. The limitations of claim 11 are rendered in the means-plus-function format and are explicitly intended by Applicant to be interpreted under 35 U.S.C. § 112, Paragraph 6.


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In view of the foregoing discussion, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned attorney at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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APPENDIX
VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

The claims are amended as follows:

1. A process of ~~for~~ transmitting a telephone number of a desired subscriber from a directory enquiry facility to a terminal connected to the directory enquiry facility over a telecommunication network with a first channel for voice transmission and a second channel for data transmission, said process comprising ~~the steps of:~~

transmitting an enquiry with the data describing the desired subscriber from the terminal to the directory enquiry facility on the first channel;

transmitting the telephone number in the form of a numeric string from the directory enquiry facility to the terminal on the second channel (DCHAN);

receiving the numeric string at the terminal;

determining the telephone number from the numeric string; and

storing the telephone number in a memory in the terminal provided for direct dialing ~~dialling~~ of telephone numbers

2. A process according to claim 1, whereby the directory enquiry facility also issues an action command that causes the terminal to determine the telephone number from the numeric string and to save the telephone number in the memory in the terminal provided for direct dialing ~~dialling~~ of telephone numbers.

3. A process according ~~accoridng~~ to claim 1, whereby the telephone number is displayed on a display in the terminal.

9. A directory enquiry facility according to claim 6, wherein the facility is equipped

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to issue an action command which causes the terminal to determine the telephone number from the numeric string and store that telephone number in a memory of the terminal provided for direct dialing dialling of the telephone number.

Claim 11 is added as a new claim.